

REMARKS

By the present amendment, claims 1 through 4, 9, 15, 16 and 26 through 34 have been cancelled. Claims 5, 6 and 10 have been rewritten to depend from claim 13 (or claims that depend from claim 13) which has been amended to more particularly recite attributes of the shock absorber adjusting nut and related cooperative parts on the wrench. Independent claim 12 has been amended to more particularly recite features of the wrench and nut assembly. Method claim 35 has been amended in a manner generally similar to that of claim 13, while the remaining claim amendments are made to reflect proper claim dependency in light of amendments to the corresponding independent claims.

REJECTION UNDER 35 USC 112, 1st PARAGRAPH

The Examiner rejected dependent claim 37 for reciting a thrust bearing that according to the Examiner was violative of the enablement requirement under 35 USC 112, first paragraph. The Applicant respectfully submits that, in addition to original claims 34 and 37, the term is discussed in both paragraphs on page 6 of the original specification, where "the thrust bearing acts as an axial spacer between the springs of the shock absorber and the nut." In addition, "the thrust bearing can be placed between the spring perch adjustment nut and the spring." Similarly, the thrust bearing is identified as washer-like bearings 160 in FIGS. 4B and 5B, where it is situated on top of spring perch 24. It is further shown in FIG. 6. On page 5 of the Office Action, the Examiner takes Official Notice that "the use of thrust bearings is notoriously old and well known in the art for engagement with a nut to hold the nut in place." The Applicant thus believes that the depictions in the figures of a thrust bearing, in conjunction with the awareness by the Examiner and those skilled in the art of the general nature and use of thrust bearings in shock absorber assemblies, are enough to demonstrate an enabling use of the claimed thrust bearing.

REJECTIONS UNDER 35 USC 102(b), (e)

To anticipate a claim, a single reference must disclose each and every positively recited

limitation. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). Since none of the cited references teach the cooperation of a shock absorber adjustment nut and a ratcheting wrench where the nut includes inner threads that can be engaged with complementary threads on a shock absorber and outer teeth or serrations that engage ratchet pawls on the wrench, they can no longer be relied upon to anticipate independent claims 12, 13 or 35.

REJECTIONS UNDER 35 USC 103(a)

"To establish a *prima facie* case of obviousness, three basic criteria must be met." MPEP 2143. One of the requirements is that all of the claim limitations must be taught or suggested. MPEP 2143.03. As discussed above, there is no evidence that any of the '313, '564 or '757 patents, or in the '642 published application teaches the claimed shock absorber wrench and nut combination. For example, the '313 patent is entirely silent as to the presence of the claimed nut. The '564 patent teaches a ratchet wrench with a cooperative head 23 that itself is hexagonally shaped (see FIG. 4) to engage a nut (not shown or described). As such, it too lacks the claimed recitation of the nut as a part of the shock absorber adjusting assembly. The '757 patent is similarly deficient to the '564 patent, as it describes a wrench 10 with socket member 24 that is hexagonal-shaped to be "positioned about a given nut or bolt head" as described at column 3, lines 43 through 46. The '642 published application is similar to the '564 and '757 patents in that it teaches a ratchet wrench 10 with a C-shaped engaging member 30 that has a generally faceted inner surface 31 that "is engaged with an object such as a nut (not shown)."

None of these shortcomings are corrected by the '354 or '374 patents, as both of these depict closed-ended ratcheting wrenches with no discussion of the claimed shock absorber adjusting nut. As such, MPEP 2143.03 is not satisfied, and any the reliance on a combination of these references to teach the claimed invention is misplaced.

Likewise, the '468 patent does not correct the deficiencies of the cited primary references. First, it (in conjunction with any of the other cited art) does not satisfy the strictures of MPEP 2143.03 that all of the claimed elements be taught. Second, there is no motivation to combine

the references contrary to MPEP 2143.01. Regarding the requirement that the combined references teach every feature of the claimed invention, the '468 patent teaches a bicycle lock nut 1 that includes a threaded interior 6 that can be turned by a wrench to engage faceted surfaces 4 on the outer surface of nut 1. Nevertheless, lock nut 1 is devoid of an outer surface with projecting teeth that can engage a complementary ratchet pawl. At most, lock nut 1 includes periodically-spaced indentations or splines that are used for hand-tightening of the nut prior to applying a wrench to the hexagonal faceted surfaces 4. There is no indication that the surface containing the spaced indentations is compatible with a wrench; by failing to teach the wrench-compatible toothed outer surface, any combination of the '468 patent with the other cited references does not satisfy MPEP 2143.03.

Even if the lock nut 1 of the '468 patent were to teach all of the claimed features (which it does not), there is nothing to justify its combination with the primary references, as it neither discusses nor contemplates such a combination with a ratcheting wrench. Regarding the requirement that there be motivation to combine the references as a part of satisfying the Examiner's burden of establishing a *prima facie* case of obviousness, there is no indication that the beveled surfaces (best shown in the combination of FIGS. 1 and 2) of the splines are compatible with or could securely engage the detents on a spanner or related wrench. Such a suggestion would be against the manifest weight of authority, as such beveled surfaces form the sort of "stripped" surfaces that ordinary engagement between a wrench and a nut with wrench-engaging outer surfaces seeks to avoid. As such, the splined outer surface of lock nut 1 is not compatible with any form of wrench tightening, in that the faceted surface 4 above it is expressly deemed compatible with such wrench tightening, as column 3, lines 32 through 35 states that the hexagonal faceted surface is for engaging a spanner, wrench or related tool. By having its splined surface incompatible with wrench-based turning, lock nut 1 teaches away from the wrenches of the other cited art as well as the wrench of the claimed invention. Teaching away has been held to present a classic case of the antithesis of motivation, as such a teaching away is a *per se* demonstration of lack of *prima facie* obviousness. See, e.g., *In re Dow Chemical Co.*, 5 USPQ2d 1529 (Fed. Cir. 1988). Furthermore, the splined outer surface attributes must be considered when determining the applicability of the cited references, for a "prior art reference

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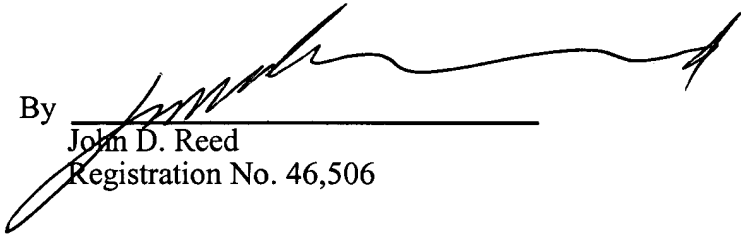
must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983, as cited in MPEP 2142.02). Thus, by failing two parts of the tripartite test for establishing a prima facie case for obviousness, no combination of the '468 patent with any of the cited primary references can be relied upon to sustain an obviousness rejection of the amended claims.

CONCLUSION

Accordingly, the Applicant respectfully submits that the application and all the remaining claims are now in condition for allowance. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, notification of allowable subject matter is respectfully solicited.

Respectfully submitted,
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